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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/233,860 01/20/99 HUTCHINSON

S BVEW:154

EXAMINER

TM02/0813

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ART UNIT

PAPER NUMBER

2123

DATE MAILED:

08/13/01

20

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20

Application Number: 09/233,860

Filing Date: January 20, 1999

Appellant(s): Scott H. Hutchinson and Gregory M. Hanka

Hugh R. Kress
For Appellant

MAILED

AUG 13 2001

Technology Center 2100

EXAMINER'S ANSWER

This is in response to Appellant's Second Substitute Brief on Appeal filed May 16,
2001.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief. Specifically, the real party of interest in this Appeal is BindView Development Corporation, a Texas corporation. Further, Appellant has elected under 37 C.F.R. § 3.71 to prosecute the Application to the exclusion of the inventors.(Paper 9)

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is not correct.[paper 7, 15, and 19, captioned section C. Status of Claims] **Examiner has attempted twice to have Appellant correct this error to no avail.** Specifically, claims 1-3, 5-8, 10-13, 15, 16, 18-24 are on Appeal since claims 4, 9, 14 and 17 have been cancelled.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

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(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because it is not directed to that which is actually recited within the claim. Specifically, Applicant is stating in summary that the invention is directed to "The disclosed invention, therefore, involves a system whereby the efficacy of tracking a network node's NIC address is substantially augmented through the introduction of a protocol which accounts for unpredictable and otherwise untraceable changes in a component's NIC address." (Pages 2-3, Summary of the Invention, SUBSTITUTE APPEAL BRIEFS, papers 7, 15 and 19) Further, Appellant is reading into the claims limitations, structure and functionality that is not present in the claims on Appeal. Lastly, Appellant has provided preemptive arguments that do not lend themselves to directing the Board to the claimed invention.

Therefore, the summary as provided is not directed to the claim limitations as recited and on Appeal. Appellant's specification recites that the instant invention is directed to an asset management system with an auditing feature that allows the system to provide attributes regarding software and/or software configuration of the node that tend to be unique within a given network. A NIC address is considered a reliable identification. In the alternative, for example in an Internet environment, the NIC address may not be used. The auditing mechanism is an agent running on the client and server nodes to provide information about the node to the other. Alternately, an audit command can be initiated from the server to the node to elicit the information. Appellant's specification and claims are directed to aforementioned and the use of an agent to provide a server

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with both asset management information and two NIC addresses (current and past). (Appellant's specification line 11, page 4 - line 12, page 5, page 14, line 15 - page 22, line 23).

Exemplary recitation of the claim as supported is directed to a method, executed by a node on a network, where the node comprises at least one asset, of transmitting asset-management information about the node, the method determining a current address value of a network interface card of the node, referred to as a NIC address value, retrieving from a data storage at the node a former NIC address value for the node and transmitting asset management information concerning the node together with the current NIC address value and the former NIC address value. (Claim 1) Therefor, not to over simplify Appellant's invention, but the root of the invention is to send configuration information from the node (computer) to a server that tracks changes in the node configurations over time. This is to say the instant invention collects data that is embodied in all computers and sends the information to a server that manages the nodes in a fashion that has been incorporated into standard protocols for such systems.

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(6) Issues

The Appellant's statement of the issues in the brief are partially correct. Specifically, claims 1-3, 5-8, 10-13, 15, 16, 18-24 are on Appeal since claims 4, 9, 14 and 17 have been cancelled. **Examiner has attempted twice to have Appellant correct this error to no avail.**

No arguments have been proffered, until the instant SECOND SUBSTITUTE APPEAL BRIEF, regarding the rejection under 35 U.S.C. § 112 para. four. Therefore, this particular issue should be moot.(papers 7, 15, and 19, captioned sections F. ISSUES subparagraph (a) and (c), H. Argument, indented subsection 2.)

(7) Grouping of Claims

The rejection of claims 1-3, 5-8, 9-13, 15-16 and 18-24 stand or fall together because Examiner agrees that the grouping is partially correct for Appeal. Claim grouping is based on Appellant's prior arguments and includes only those claims remaining in the case to appeal.

Specifically, claims 1-3, 5-8, 10-13, 15, 16, 18-24 are on Appeal since claims 4, 9, 14 and 17 have been cancelled. **Examiner has attempted twice to have Appellants correct this error to no avail.** [papers 7, 15, and 19, captioned section entitled G. Grouping of Claims]

Appellant has not previously argued the issue of the rejection based on 35 U.S.C. § 112 para. four. Examiner has lumped the 1st and 2nd apparent groupings of Appellant into Group 1. This is proper since they have only been argued together. Further, Appellant has not previously

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argued the 112 paragraph four issues at all. This argument is anew and should be moot. See 37 CFR § 1.192(c)(7).

GROUP I: Claims 11-12.

GROUP II: Claims 1-3, 5-8, 10-13, 15, 16, 18-24.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is not correct. Claim 2 is dependent on Claim 2. Examiner has attempted to have Appellant correct this to no avail. This is not representative of the claims pending in the case. This is presumed a typographic error. Moreover, claims 1-3, 5-8, 10-13, 15, 16, 18-24 are on Appeal since claims 4, 9, 14 and 17 have been cancelled.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,878,420	de la Salle	3-1999
5,923,850	Barroux	7-1999

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(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

GROUP I: Claims 11 and 12 are rejected under 35 U.S.C. 112 paras. two and four. This rejection is set forth in prior Office action, Paper No. 8 and Paper No. 6.

GROUP II: Claims 1-3, 5-8, 10-13, 15, 16, 18-24 are rejected under 35 U.S.C. § 102(e). This rejection is set forth in prior Office action, Paper No. 8.

GROUP I

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are written in a manner that does not distinguish them as either method or computer readable medium, but rather some type of hybrid wherein the computer readable medium cannot be clearly correlated to specific method steps. "A program storage device readable by a processor in the node of a specified one of claims 1 through 3, 5 through 7, and 21 through 24, and encoding a program of instructions including instructions for performing the operations recited in said specified claims" and "A program storage device readable by a processor in the server

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node of a specific one of claims 8, 10 and 24 and encoding a program of instructions including instructions for performing the operations recited in said specified claims” are unclear because a program storage device readable by a processor and encoding a program of instructions for performing the operations cannot be clearly correlated to the method steps. Further, the issue of which grouping of independent and dependencies that are within the claims is actually being recited is obscure. In the last line the addition of the words, “ in said specified claims ever further obscures the meaning. The examiner is left to speculate to the intended meaning of these claims.

The following is a quotation of the forth paragraph of 35 U.S.C. 112:

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim shall in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

Claims 11 and 12 are rejected under 35 U.S.C. 112, forth paragraph, for failing to further limit the claim that each depends from. “A program storage device readable by a processor in the node of a specified one of claims 1 through 3, 5 through 7, and 21 through 23, and encoding a program of instructions including instructions for performing the operations recited in said specified claims” and “A program storage device readable by a processor in the server node of a specific one of claims 8 and 10 and encoding a program of instructions including instructions for performing the operations recited in said

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specified claims” imply the same scope relative to the claims to which each depends. In other words, where ever a dependent claim recites the same limitations within a group of claims that does not expressly provide a new limitation the dependent claim does not further limit the claims to which each dependent claim refers.

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GROUP II

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-3, 5-8, 10-13, 15, 16, 18-24 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Barroux or de la Salle.

Taking claim 1, for example, Barroux and de la Salle disclose:

determining a current address value of a network interface card of the node, referred to as a NIC address value, retrieving from a data storage at the node, a former NIC address value for the node and transmitting asset management information concerning the node together with the current NIC address (MAC address, present configuration). and the former NIC address (MAC address for prior configuration).

As to claim 2, the method of claim 1, wherein determining the current NIC address includes an attempt to detect the then current NIC address value (MAC address).

As to claim 3, the method of claim 2, wherein the attempt to detect the current NIC address value is unsuccessful, and further comprising:

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retrieving, from a data storage at the node, a stored value containing the result of the past live detection of the then-current NIC address value (current MAC address) referred to as a previously detected NIC address value (last MAC address); and transmitting the previously detected NIC address value (last MAC address) as taught throughout Barroux and de la Salle. (Barroux: SNMP Probe, MAC address, ifPhysAddress object; de la Salle: Board address Object and probe)

Claim 5 recites providing the NIC address value comprises a signature portion and a pseudo randomly generated portion which is the industry standard for generating the MAC addresses stored within the MAC address pool as taught throughout Barroux and de la Salle. (Barroux: SNMP Probe, MAC address, ifPhysAddress object; de la Salle: Board address Object and probe)

Claim 6 recites the use of redundant storage as taught throughout Barroux and de la Salle. (Barroux: SNMP Probe, MAC address, ifPhysAddress object; de la Salle: Board address Object and probe)

Claim 7 recites the use of a time stamping to determine the last NIC address assigned as taught throughout Barroux and de la Salle. (Barroux: SNMP Probe, MAC address, ifPhysAddress object; de la Salle: Board address Object and probe)

As to claim 13, recites in a node on a network, a data store comprising a machine readable data structure accessible to a processor in the node and containing node-

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identification for the client node that includes a current network interface card value for the node, referred to as a NIC address value and a former NIC address value as taught throughout Barroux and de la Salle (Barroux: SNMP Probe, MAC address, ifPhysAddress object; de la Salle: Board address Object and probe)

Claims 8, 13, 16, 19, 21-24 are rejected for the same reasoning as claims 1-3 and 6-7, set forth above, supra. Claims 8, 16, 19, 21-24 contain the same limitations as the equivalent claims 1-3 and 6-7 and as taught throughout Barroux and de la Salle.

Claims 10, 15, 18 and 20 are rejected for the same reasoning as claim 5, set forth above, supra. Claims 10, 15, 18 and 20 contain the same limitations as recited in claims 10, 15, 18 and 20 and as taught throughout Barroux and de la Salle.

As for claims 11 and 12 are rejected for the same reasoning as the claims to which they respectively depend, claims 1 through 3, 5 through 7 and 21 through 24 and 8, 10 and 24, respectively, as set forth above, supra. Claims 11 and 12 are interpreted as merely the equivalent computer-readable medium claims containing the same limitations as claims 1 through 3, 5 through 7 and 21 through 23 and 8 and 10, respectively, as taught throughout Barroux and de la Salle. Claims 11 and 12 have been interpreted based on the presumption that every possible combination and redundancy is taught in the prior art applied since either reference teach the embodied invention as

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claimed in the proper claims. In general, as pointed out in the rejection of claims 11 and 12 they are indefinite in their nature and impossible to exact a meaningful interpretation.

(11) *Response to Argument*

Examiner provides response based on the grouping of claims I and II, to Appellant's arguments. Appellant has addressed their arguments for Group I within indent sections 1 and 2 (pages 5-8) and Group 2 within indent sections 3 and 4 (pages 8-18):

GROUP I

As can be seen from the prosecution history, Appellant has been silent on the rejection of claims 11 and 12 under 35 U.S.C. § 112 paragraph four, thereby conceding to the rejection. The arguments now presented in the instant Substitute Brief directed to this issue are not timely, late coming, an after thought and therefor moot.

Examiner rejected claims 11 and 12 under 35 U.S.C. § 112 paragraph two as being indefinite in nature. The root of this issue lay within the construction Appellant had defined anew and which yields an abundance of probable claims, and redundant and/or circular claim limitations thereby rendering the claims indefinite in nature. Appellant has not provided claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Appellant's representative has asserted the position that *In re Warmerdam* (*Warmerdam*) can be used to overcome the rejection. Examiner respectfully disagrees. The facts in *Warmerdam* are similar and so is the beginning claim language and structure, however, merely being similar in there nature does not mean they are equivalent in their nature. Specifically looking at the claim language of *Warmerdam*:

“A machine having a memory which contains data representing a bubble hierarchy generated by the method of any of Claims 1 through 4.”

Now take Appellant's claim 11 language:

“A program storage device readable by a processor in the client node of a specified one of claims 1 through 3, 5 through 7, **and** 21 through 24, **and** encoding a program of instructions including instructions **for performing the operations recited in the specified claim** as being performed by the client node”
[emphasis added]

As can be plainly seen, the language and the constructs are very different and require a completely different interpretation of the language. The applicants language of “of a specified one of claims 1 through 3” is within the practice and interpretation of the *Warmerdam* decision.

However, that is where the similarity ends. Specifically, Appellant continues then uses language separated with a “,” and then a new series of claims “5 through 7”, the conjunctive “**and**” and then finally a new series of claims “21 through 24”. Appellants have then added further limitations to the claims with “**and** encoding a program of

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instructions including instructions for performing the operations **recited in the specified claim** as being performed by the client node”.

Examiner proffers that this is not within the scope, meaning and reasonable interpretation of *In re Warmerdam* decision. Further, the additional limitations provide an ambiguity to the claim language in a way as to make proper and reasonable interpretation of the language impossible.

Appellant has stated in FN[2], of Substitute Brief, page 6, that the nature of claims 11 and 12 are Markush-type claims. Looking to *Ex parte Markush*, 1925, C.D. 126, the nature of the claims do not present as genus and subgenus, are not mixtures of chemical compounds and not recited in the accepted manner of stating that the it is “**selected from the group consisting of A, B and C.**” *Ex parte Markush* sanctions claiming a genus expressed as a group consisting of certain specified materials. Inventions in metallurgy, refractories, ceramics, pharmacy, pharmacology and biology are most frequently claimed under the Markush formula but purely mechanical features or process steps may also be claimed by using the Markush style of claiming. See *Ex parte Head*, 214 USPQ 551 (Bd. App. 1981); *In re Gaubert*, 524 F.2d 1222, 187 USPQ 664 (CCPA 1975); and *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980). It is improper to use the term “**comprising**” instead of “consisting of.” *Ex parte Dotter*, 12 USPQ 382 (Bd. App. 1931). MPEP states: “The use of Markush claims of diminishing scope should not, in itself, be

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considered a sufficient basis for objection to or rejection of claims. However, if such a practice renders the claims indefinite or if it results in undue multiplicity, an appropriate rejection should be made.” In the instant case, it is seen that Appellant has divested them self from using the standard and accepted practice that makes as claim a Markush-type. Further the groups in a Markush claim are products, compounds or process steps not claims. This is a multi dependent structure. The claims are indefinite in their nature and therefore, even if they met this standard, they would be properly rejected.

Claims 11 and 12 are, at best, a mix and match of independent and dependent claims provided in a multiplicity of forms with multiple claims spanning method and program product claim constructs with differing and similar claim limitations. These are not in the structure or spirit of Markush-type claims. This is an attempt, in a single claim structure, to claim all possible permutations of claim features and/or limitations. This provides a confused assortment of claims, limitations and redundancies. There is not a safe harbor for this formulary of claim language in the Markush type claims.

Taking claim 11 to heart, an exemplarily construct using Appellants’ claims can result in a number of permutations that are improper constructions and redundant in nature. A large number of permutations are possible, I have provided only two:

Claim 11 (version 1)

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A program storage device readable by a processor in the client node of a specified one of claim 2 and claim 7 and claim 21 *[examiner selected one claim from each grouping to yield one composite set of limitations]* and encoding a program of instructions including instructions for performing the operations recited in the specified claim *[perhaps 2, maybe 7, alternately we might be talking about 21]* as being performed by the client node. [Emphasis added]

Analysis of claim 11 (dependent or independent) is obscure at best.

Claim 11 provides for a program storage device readable by a processor in the client node of claim 2, a method dependent on claim 1, wherein determining the current NIC address value includes an attempt to detect the then-current NIC address value AND claim 7, the method dependent on dependent claim 6, which is in turn is dependent on claim 1, wherein (x) each copy of the former NIC address value is associated with a time stamp, and (y) retrieving the former NIC address value comprises retrieving the respective copy associated with the most recent time stamp AND independent claim 21, a method, executed by a node on a network, of transmitting asset-management information about the node, the method comprising:

(a) determining a current node identifier value, where (1) the node identifier value for any particular node in the network is dependent upon one or more node-identification attributes of that node including an address value of a network interface card in the node, referred to as a NIC address value, and (2) determining the current node identifier value includes an attempt to detect the then-current values of said one or more node-identification attributes;

(b) retrieving, from a data storage at the node, a former node identifier value for the node; and

(c) transmitting asset-management information about the node together with the current node-identifier value the former node identifier value

the method of claim 1, wherein the former NIC address is redundantly stored in multiple partitions within the data storage at the node and

encoding a program of instructions including instructions for performing the operations recited in the specified claim 2, a method dependent on claim 1, wherein determining the current NIC address value includes an attempt to detect the then-current NIC address value OR claim 7, the method dependent on dependent claim 6, wherein (x) each copy of the former NIC address value is associated with a time stamp, and (y) retrieving the former NIC address value comprises retrieving the respective copy associated with the most recent time

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stamp **OR** independent claim 21, a method, executed by a node on a network, of transmitting asset-management information about the node, the method comprising:

(a) determining a current node identifier value, where (1) the node identifier value for any particular node in the network is dependent upon one or more node-identification attributes of that node including an address value of a network interface card in the node, referred to as a NIC address value, and (2) determining the current node identifier value includes an attempt to detect the then-current values of said one or more node-identification attributes;

(b) retrieving, from a data storage at the node, a former node identifier value for the node; and

(c) transmitting asset-management information about the node together with the current node-identifier value the former node identifier value as being performed by the client node.

Examiner has interpreted the phrase “for performing the operations recited in the specified claim as being performed by the client node” as an **OR** however, one could just choose one of the claims 2, 7 or 21. The resulting claim 11 yields a depend claim 2 with an dependent claim 7 attached to an independent claim that neither 2 or 7 are dependent upon. Functionally, this would mean to interpret claim 11 would include all the limitations as recited in claim 1, 2, 6, 7 and 21 with redundant limitations throughout two independent claims and limitations provided in as dependencies that are separate from the merged independent claim. Further, providing additional claim limitations and the folding back in of limitations recited in claim 1 and 2, 6 and 7, or 21 renders the claims indefinite. Interpreting this claim for determination of patentability is very difficult, if not impossible. This appears well outside a reasonable interpretation of *Warmerdam*.

Claim 11 (version 2)

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A program storage device readable by a processor in the client node of a specified one of claim 1 and claim 7 and claim 21 *[examiner selected one claim from each grouping to yield one composite set of limitations]* and encoding a program of instructions including instructions for performing the operations recited in the specified claim *[perhaps 1, maybe 7, alternately we might be talking about 21]* as being performed by the client node. [Emphasis added]

Claim 11 provides for a program storage device readable by a processor in the client node of claim 1, a method, executed by a node on a network, said node comprising at least one asset, of transmitting asset-management information about the node, the method comprising:

(a) determining a current address value of a network interface card of the node, referred to as a NIC address value;

(b) retrieving, from a data storage at the node, a former NIC address value for the node; and

(c) transmitting asset-management information concerning the node together with the current NIC address value and the former NIC address value AND claim 7, the method dependent on dependent claim 6, wherein (x) each copy of the former NIC address value is associated with a time stamp, and (y) retrieving the former NIC address value comprises retrieving the respective copy associated with the most recent time stamp AND independent claim 21, a method, executed by a node on a network, of transmitting asset-management information about the node, the method comprising:

(a) determining a current node identifier value, where (1) the node identifier value for any particular node in the network is dependent upon one or more node-identification attributes of that node including an address value of a network interface card in the node, referred to as a NIC address value, and (2) determining the current node identifier value includes an attempt to detect the then-current values of said one or more node-identification attributes;

(b) retrieving, from a data storage at the node, a former node identifier value for the node; and

(c) transmitting asset-management information about the node together with the current node-identifier value the former node identifier value depend claim 6 , the method of claim 1, wherein the

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former NIC address is redundantly stored in multiple partitions within the data storage at the node and

encoding a program of instructions including instructions for performing the operations recited in the specified independent claim 1, a method, executed by a node on a network, said node comprising at least one asset, of transmitting asset-management information about the node, the method comprising:

(a) determining a current address value of a network interface card of the node, referred to as a NIC address value;

(b) retrieving, from a data storage at the node, a former NIC address value for the node; and

(c) transmitting asset-management information concerning the node together with the current NIC address value and the former NIC address value OR dependent claim 7, the method dependent on dependent claim 6 depend on method of claim 1, wherein the former NIC address is redundantly stored in multiple partitions within the data storage at the node and, wherein (x) each copy of the former NIC address value is associated with a time stamp, and (y) retrieving the former NIC address value comprises retrieving the respective copy associated with the most recent time stamp OR independent claim 21, a method, executed by a node on a network, of transmitting asset-management information about the node, the method comprising:

(a) determining a current node identifier value, where (1) the node identifier value for any particular node in the network is dependent upon one or more node-identification attributes of that node including an address value of a network interface card in the node, referred to as a NIC address value, and (2) determining the current node identifier value includes an attempt to detect the then-current values of said one or more node-identification attributes;

(b) retrieving, from a data storage at the node, a former node identifier value for the node; and

(c) transmitting asset-management information about the node together with the current node-identifier value the former node identifier value as being performed by the client node.

This claim 11 is even more interesting in that it contains two independent and two dependent claims. Claims 6, 7 are not dependent on the independent claim 21. Functionally, this would mean to interpret claim 11 one would include all the limitations as recited in claim 1, 6, 7 and 21 with redundant limitations throughout two independent claims and limitations provided in dependencies that are separate

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from the merged independent claim. Further, providing additional claim limitations and then folding back in of limitations recited in claim 1, 6 and 7, or 21 renders the claim indefinite. Interpreting this claim for determination of patentability is difficult, if not impossible. This appears well outside a reasonable interpretation of *Warmerdam* as well.

Claims 11 and 12 can be both independent and dependent in their individual natures. Taking claim 11 with 2, 7 and 22 yields a possible dependent claim with all limitations inclusive. Alternately, taking claim 11 with 1, 5, and 24 result in a mixed mode of independence and dependencies that can possibly looked at as an independent claim with composite limitations from two independent claims plus the dependent claim limitations.

Therefore the language as applicant has provided is clearly indefinite in nature and defective. Claim 12 is constructed in the same fashion and therefor has the same ambiguities, is indefinite and defective.

In response to the allegation that these types of claim constructs are not indefinite, the Examiner proffers that any person that is skilled in the art or of ordinary skill level would have a particularly difficulty time, if not impossible time, in determining whether or not that person was infringing upon any one of the permutations of the claim language that could be reasonably inferred from the

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ambiguous language as applicant has claimed.(Paper 7) Lastly reducing these permutations to practice would be equally as difficult, if not impossible to the person of ordinary skill level in the art.

Examiner will also point out that there are functional and procedural difficulties Appellant's style of claim language provides. Firstly, the claim 11 can not be examined, allowed or rejected in total. The mere use of this format makes rejecting and allowing sub-parts difficult if not impossible. **Appellants merely needed to restate the claims in conventional independent and dependent form to make them individually and/or together allowable or rejectable in view of the art of record.**(restated for clarity) (Papers 6,8)

Though a fee has been charged for multiple dependent claim language, no fee has been levied on the number of possible permutations of claims to be Examined. Further, there is no fee to cover the redundancies when such claims are constructed as Appellant has argued as correct in their individual nature.

Appellant's construction deviates from the standard method of claiming multiple dependent claims and causes new issues when attempting to interpret the proper scope and limitations of the claim language as currently proffered as acceptable. Taking this approach the claim 11 that includes claims 2, 7 and 21 yield an improper multiple dependent construction, since the claims are not recited in the

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alternative. Examiner does not agree with the applicants' opining that claims 11 and 12 are "also a 'good thing' on policy grounds because they promote judicial economy. Such claim constructs can be asserted against a vender of 'infringing' software as a direct infringer without the patent owner to prove the extra elements required for active inducement of infringement or contributory infringement. Such claims therefore help conserve resources, both for litigants and for the judicial system". (Paper 7) This is without merit and is a mere allegation since it is without evidence. Further, Appellant's approach causes a more protracted and difficult prosecution of the instant invention. This process provides no more than a manner in which to ensure the instant invention in prosecution outside the bounds of normal endeavors. The claim construction provides claims that are indefinite and places an undue burden on the Examiner.

Examiner proffers that, infringement or interference determinations (two or one way test) would be impossible if Appellant's style of claim language were used. Appellant's style makes determining the distinctions between inventions or products and the claims within the case difficult if not impossible.

Claims 11 and 12 appear to be an attempt at constructing new hybrid claims that are a merging of *In re Warmerdam*, 33 F.3d 1354 (Fed. Cir. 1994) and *In re Beauregard* (CA FC) 35 USPQ2d 1383(1995) claim constructs. The morphed claim

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construction has resulted in indefinite claim language. The language does not appear to represent a program-by-process or a program storage device, yet an apparatus with method steps. Examiner directs Appellant to *Ex parte Lyell*, 17 USPQ 2nd 1548 (Bd. Pat. App. & Inter. 1990) which seems very relevant in that claims 11 and 12 recite a **program storage device** and then **integrate method steps**. As recited from the MPEP 2173.05(p): "A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. § 112, second paragraph." *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), Further, see *Cyril Corp. V. Intel Corp.* (DC Texas) 32 USPQ2d 1890 (1/21/1994).

Lastly, the examining procedures do not provide for handling such claim language, as Appellant have proffered as acceptable practice. Primarily, since the style in which Appellant is relying upon is not accepted practice there is no direction except that it is indefinite and improper in its nature. Examiner can not separate the claims to provide applicants with claims that can be dissected for rejection and/or allowance. Claim 12 has the same problems of including the conjunctive "and" between the individual selection of a specified one of claims 8, 10, and 24 with the conjunctive of "and" then "encoding a program of instructions including instructions for performing the operations recited in said specified claim (**8 or 10 or 24**) as being performed by the client node. Examiner has used the examples afore to outline the

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difficulty associated with examining such claim constructions. Claim 12 has the same problems associated with claim 11.

Appellant has further argued that formulations of claims 11 and 12 is undeniably precedented. (Page 7, Substitute Brief) The examiner can only note that FN[3] provides for differing search terms that are not present in the claim constructs (see Appendix A). Further, the issue of indefiniteness is not hinged on either term as searched. As to the issue of whether issued U.S. Patent No. 5,860,929 (claims 11 , 19 and 20) provides support for this assertion, the Examiner can only direct the Appellant to MPEP 1701 section entitled: **Office Personnel Not To Express**

Opinion on Validity or Patentability of Patent, which states:

Every patent is presumed to be valid. 35 U.S.C. 282, first sentence. Public policy demands that every employee of the Patent and Trademark Office refuse to express to any person any opinion as to the validity or invalidity of, or the patentability or unpatentability of any claim in any U.S. patent, except to the extent necessary to carry out

- (A) an examination of a reissue application of the patent,
- (B) a reexamination proceeding to reexamine the patent, or
- (c) an interference involving the patent.

The question of validity or invalidity is otherwise exclusively a matter to be determined by a court. Members of the patent examining corps are cautioned to be especially wary of any inquiry from any person outside the Patent and Trademark Office, including an employee of another Government agency, the answer to which might indicate that a particular patent should not have issued.

For the above reasons, it is believed that the rejections should be sustained.

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GROUP II

Appellant's have charged that both of the cited references assume away the very essence of the problem to which the present invention is directed. Further, the present invention is directed to an asset management system for a computer network with a key feature of having the ability to **uniquely identify** each **node** on the **network**. Appellant has proffered that "Table 1 embodies a comparison between possible identifiers for a node (computer) and that the **only one attribute** -- one that **has not found widespread acceptance** among computer equipment manufactures -- was not susceptible to failure as a **node identifier**."

Appellant has opined that in the cited references, on the other hand, the existence of **unique identifiers** for **network nodes** is **not discussed**; rather, it is **assumed**. That the cited references completely ignore the problem sought to be solved by the present invention, and indeed take as their respective fundamental premises that such a problem does not exist. As a result each cited reference fails to teach or suggest critical elements of the claimed invention.

Examiner has a number of fundamental issues to bring forward in regards to Appellant's initial statements. Firstly, the basis for Appellant's claimed invention is spelled out as an asset manager which collects and sends asset information with historical data representing the current NIC address and the former NIC address. The

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unique identifiers for network nodes as stated within Appellant's specification is in fact the NIC address which is defined as the MAC address located in network cards. In any given installation (network), it is safe to assume that all NIC addresses are unique. (Page 10, lines 5-10) A node's NIC address represents a reliable client node 101 identification method. The caveat, however, is that network interface card movements must be tracked somehow. The node-identifier records 305 and the central database provide tools that can be used in such auditing. (Page 15, lines 21-24) The system uses an audit command that triggers the client node to send to a server the history of the node with any changes that may have occurred, including the MAC address - alternately labeled the NIC address.

The prior art references explicitly teach using **unique identifiers** for nodes on a network with a manager that sends a "probe" function, or alternately uses an agent, to send collect historical information pertaining to the attributes, configurations and hardware located at the node. Both teachings discloses various possible **unique identifiers** including the MAC address (NIC address) and related information from the node. Alternately they disclose using an assigned **unique identifier** separate from the MAC address. It is noted that Appellant also provides such an alternate embodiment. The prior art is using underlying protocols with adaptations to solve the same problem that Appellant has argued as novel.

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Appellant has attempted to make the following distinctions over the prior art of record:

- 1) Asset verses Network management.(de la Salle)
- 2) That somehow the NIC address is not viable as a unique identifier based on the prior art teachings.(de la Salle and Barroux)
- 3) Continuous operation (de la Salle) verses audit based
- 4) Unique identifier is assumed to exist for each node in the network (Barroux)
- 5) In summary the Appellant states that neither reference can not use the current and former node identifying values.

Not to overly simplify the Appellant's arguments, but these are not very strong distinctions. As to asset verses network management, the intended use is just that an intended use. There is no functional distinction between the two systems. Asset management is the collection of attributes, configurations and hardware information from a node (computer). Network management provides a system to collect attributes, configurations and hardware information from a node (computer). They serve the same function, to collect information from nodes and store data representing this collected information at a local management repository that may be distributed.

Appellant position that in someway the NIC address is not viable as a unique identifier based on prior art teachings is an interesting approach since the use of the

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NIC address is acceptable for Appellant's claimed invention, *id.* The prior art citations and the Appellant's instant invention uses the same **unique identifier**. All use the NIC or MAC address as a reference point for acknowledging the current node is the same as the previous node that sent asset or management data in a prior cycle.

Continuous operation (de la Salle) verses audit based (Appellant) is interesting since network monitoring and management systems, such as those incorporated in de la Salle all allow for systems to go down and reinitialize. These steps allow for an audit to occur where the server and nodes confirm configurations as previously stored in databases such as the MIB in a SNMP environment. They are inherent in the systems, otherwise, they would not function.

Appellant's assertion that a unique identifier is assumed to exist for each node in the network (Barroux) is based on the misunderstanding that Barroux does not explicitly teach the Appellant's instant invention. Specifically, Barroux teaches a number of unique identifiers that Appellant has listed as possible candidates. Both the Appellant and Barroux use NIC addresses and other historical data to identify a node within the network. Further, since the comparison of historical or management information within systems using SNMP includes the use of unique identifiers, it is proffered that the assumption, if any, is based on the inherent functionality of these underlying protocols.

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In summary the Appellant states that neither reference can not use the current and former node identifying values. Though this appears to be a strong point the fact is that both pieces of prior art use collection of configuration information from nodes and they both use comparisons with prior data regarding the nodes. This includes identification information or values. de la Salle teaches a network monitoring and management system which collects information about every device within the network and uses data collected with node addresses to identify the specific node and any changes that might occur.

This is fundamental in all network management systems. Barroux expressly teaches a historical asset information data storage scheme for tracking changes within network nodes, to include changes in network cards and node ID. Historical data is collected and compared based on time stamped versions to ascertain what changes have been effected within a node. Lastly, Appellant has attempted to make this distinction around the phrase “node-identifying values” however, this is not recited in claim 1 for example. Every other recitation within the claims is directed to a node identifier that is the NIC address. This is exactly what the node identifier is designated as in at least one embodiment disclosed within de la Salle and Barroux. The fact that the reference teaches the same unique identifier and provides historical data for changes, including the MAC or NIC addresses for the same end does provide

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for anticipation of Appellant's claimed invention. They perform the same functions on the same systems.

Examiner has reproduce claims 1 and 13 with a mapping of the claim limitations with the teachings of the prior art. All claims pending in the instant case have been rejected with appropriate mappings to the individual claims with teaching from Barroux and de la Salle.

Claim 1, recites a method for determining a current address value of a network interface card of the node, referred to as a NIC address value (NIC, MAC ID), retrieving form a data storage at the node, a former NIC address value for the node and transmitting asset management information concerning the node together with the current NIC address (MAC address, present configuration). and the former NIC address (MAC address for prior configuration).

Claim 13, recites in a node on a network, a data store comprising a machine readable data structure accessible to a processor in the node and containing node-identification for the client node that includes a current network interface card value for the node, referred to as a NIC address value and a former NIC address value as taught throughout Barroux and de la Salle (Barroux: SNMP Probe, MAC address, ifPhysAddress object, time stats; de la Salle: Board address Object and probe, time stats)

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Claims 8, 16, 19, 21, 23 and 24 recite limitations directed to storing the node information and providing a time stamp to the datum relating to the node information and have been effectively covered in the rejection of claims 1-3 and 5-7, *id.* Barroux and de la Salle both include these features expressly and inherently in their relative systems. (SNMP, MAC address, present configuration and MAC address for prior configuration, Barroux: SNMP Probe, MAC address, ifPhysAddress object, time stats ; de la Salle: Board address Object and probe, time stats)

Appellant has argued that the use of various RFCs has been acknowledged, however, that any inference that the cited RFCs anticipate or render obvious the claims at issue is misplaced. (Pages 17-18).

Examiner answers this charge with an observation and provides support for their use. Examiner provided these references to enlighten the Appellant that the protocols described within both de la Salle and Barroux are established and well known as underpinnings in the industry for locating nodes and related configuration (assets, attributes). MPEP 2131.01 provides guidance in these matters of supporting the base teachings with the underlying protocol suites that must be in place to allow functionality. The courts have made this clear when stating: "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such

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evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)

Moreover, courts have held that “..as long as there is evidence of record establishing inherency, failure of those skilled in the art to contemporaneously recognize an inherent property, function or ingredient of a prior art reference does not preclude a finding of anticipation”. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1349, 51 USPQ2d 1943, 1948 (Fed. Cir. 1999)

Examiner did not provide a rejection under 35 U.S.C. 103 since this is not a matter of obviousness. The issue at hand is anticipation based on the teachings of either de la Salle or Barroux and the explicit and inherent features of the underlying protocols they call into use and allow all systems to collect management, asset, attribute and configuration information. There is nothing obvious to combine references when that which is taught is well known to be inherent in the systems in such a manner that one of ordinary skill in the art would use them because they are omni present in the networking environment. Quoting from the MPEP: “The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. “The inherent teaching of a prior

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art reference, a question of fact, arises both in the context of anticipation and obviousness.” *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) In *Napier* the Examiner resigned to use the inherent argument support for a rejection under 103. In the instant case both *de la Salle* and *Barroux* call into there teachings the use of these omni present resources found as protocol suites within the network. See *In re Schreiber*, 128 F.3d 1473, 44 USPQ2d 1429 (Fed. Cir. 1997).

These references were provided to help Appellant understand that the inherent features within the protocol suits called into use within the primary references in fact included the functionality that was afforded them in the rejections. (Paper 8)

The use of underlying protocol suites instilled within the Internet and intranets have been well established. Use of their built-in and inherent features for their intended use is not patentable. Protocols used (as listed, Paper 8 on page 7) in the day to day operations of systems that make them perform these routine functions are **required** to perform the functions. The system would not be able to manage the system without them and therefore their individual presence is inherent in such systems. Appellant is using a “protocol” of method steps that operates in the same manner as the equivalent protocols with a new label. If there is a functional difference that the skilled artisan or one of ordinary skill level in the art would otherwise not be able to perform with these instilled and required protocols then

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Appellant should be able to spell out the distinctions that distinguish the independent claims from the prior art of record and the underlying protocols, *id.* For the matter that Barroux may have stated in some fashion that SNMP has been used primarily for monitoring network performance is only a small piece of the big picture and does not detract from the actual purpose of the protocols. As the courts have held “The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable.” *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

SNMP stands for “Simple Network Management Protocol” and its purpose is to manage networks to include mapping within the MIB the hardware and software configurations of the system nodes. These provide historical and timely adaptations to the network topology. In the alternate intended use term “asset management” of the underlying network topology. The courts have held that: “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (*emphasis in original*) Examiner has met this burden.

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Appellant had amended the claims to include limitations directed to the operation of an asset management system with locally stored NIC address transfers for updating the configuration files stored on a host machine. Appellant is teaching the retrieval of stored management or configuration information from a locally stored file that is sent to another node for reporting the old and new configuration data. These operations are built into the protocol suites. SNMP or CMIP agents with files are stored at the client side (Paper 8). The manager node needs to know changes in the clients within the managed network. If a change occurs, either the client agent transmits a packet listing the changes in configuration to the management node containing the MIB or the management node sends a "probe" to detect configuration changes stored in the local client files or by scanning the hardware in a routine fashion. Examiner also provided RFC 1189, directed to CMOT and CMIP which also teaches that the installed protocol suites include the Appellant's claimed invention.

The protocols underlying these operations date back over years prior to Appellant's invention. Appellant's invention is not patentably distinguishable over the prior art of record and the inherent underlying protocols. This is merely using the tools of the trade for their intended use. Further, the courts have held that "A reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings in combination with his own knowledge of the

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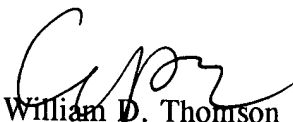
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particular art and be in possession of the invention.” *In re Graves*, 36 USPQ2d 1697 (Fed. Cir. 1995); *In re Sase*, 207 USPQ 107 (CCPA 1980); *In re Samour*, 197 USPQ 1 (CCPA 1978).

In summary, Examiner with the afore facts in hand, can not allow the instant claims on appeal over the well established, express, explicit and inherent teachings of the prior art. Appellant’s claims are directed to using the underlying and built in features of a network for their intended use. Further, Barroux and de la Salle teach using these underlying and built in features for managing and obtaining the same information for the same purpose as Appellant has claimed as the novelty of the instant invention.

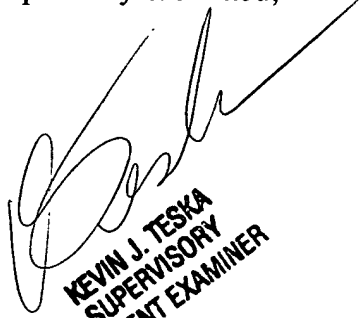
For the above reasons, it is believed that the rejections should be sustained.


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August 11, 2001

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Art Unit 2123

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Respectfully submitted,


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